

## **REMARKS**

This is intended as a full and complete response to the Office Action dated June 28, 2006, having a shortened statutory period for response set to expire on September 28, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-23 are pending in the application. Claims 1-23 remain pending following entry of this response. Claims 1, 2, 5, 6, 8, 15 and 20 have been amended. Applicants submit that the amendments do not introduce new matter.

### Interview Summary

On August 28, 2006, a telephonic interview was held between Gero G. McClellan, the Examiner Wilson Lee to discuss the utility rejection. In particular, claim 1 was discussed, which Examiner Lee suggested did not comply with the utility requirement of 35 USC § 101. In particular, the Examiner suggested that while the claims recite conditional limitations, the claims do not recite all possible outcomes for the conditions. Mr. McClellan rebutted referring Examiner Lee to MPEP 21207.01 which states that "it is [not] essential that the invention accomplish all of its intended functions...or operate under all conditions...partial success being sufficient to demonstrate patentable utility." Examiner Lee requested that Mr. McClellan's argument and a citation to MPEP 21207.01 be made in writing. In addition, Mr. McClellan proposed possible claim changes which, while not affecting claims scope, may facilitate examination of the present claims. Examiner Lee agreed that such amendments would be useful for examination purposes. As a result of the interview the parties agreed that the Applicants would submit a written response including arguments regarding the utility requirement and clarifying amendments. No references were discussed.

Claim Rejections - 35 U.S.C. § 101

Claims 1-23 stand rejected. The Examiner states that the disclosed invention is inoperative and therefore lacks utility.

Applicants respectfully traverse the rejection. The Examiner suggests that the utility requirement is not met because while the claims recite conditional limitations, the claims do not recite all possible outcomes for the conditions. For example, claim 1 recites "generating one or more indicia maps indicating which, if any, objects in the view have corresponding annotations;..." Regarding claim 1 the Examiner argues that "the claimed invention is inoperative because the invention fails to show that [sic] whether the method can generate and the indicia maps and provide indication if the objects do not have the corresponding annotations. Claims 2, 5, 6, 14, 15 and 20 are likewise rejected.

Respectfully, the Applicants are not required to amend the claims to recite what happens "if the objects do not have the corresponding annotations". MPEP 21207.01 states that "it is [not] essential that the invention accomplish all of its intended functions...or operate under all conditions...partial success being sufficient to demonstrate patentable utility." Further, the Federal Circuit has held that "[t]o violate [35 USC] 101 the claimed device must be totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced Micro Devices, Inc.* 977 F.2d 1555, 1571 (Fed. Cir. 1992). Accordingly, Applicants submit that the present affirmative recitation of "generating one or more indicia maps indicating which, if any, objects in the view have corresponding annotations;..." is sufficient to satisfy the utility requirement under 35 USC §101. Therefore, the rejection is believed to be improper and Applicants respectfully request that the rejection be withdrawn and the claims be allowed.

Despite the rejection being improper for the reasons given above, Applicants have made clarifying amendments in an effort to move prosecution forward. Applicants submit that these amendments are not narrowing and that the amendments render claims at least as broad as the original claims. Accordingly, Applicants are entitled to a full range of equivalents for any analysis under the Doctrine of Equivalents.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

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